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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/778,055 | 02/07/2001 | Yuichi Asami | Q62904 | 7352 |

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| EXAMINER |
|---|
| CAPRON, AARON J |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3714 | 11 |

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/778,055 | ASAMI ET AL. | |
| | Examiner | Art Unit | |
| | Aaron J. Capron | 3714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

The final rejection mailed March 5, 2003 is hereby withdrawn in favor of the following non-final action. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The extended prosecution of this application is respectfully regretted.

### *Information Disclosure Statement*

The information disclosure statement (IDS) submitted on April 2, 2003 was filed after the mailing date of the Final Action on March 5, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The examiner's consideration under MPEP 609 of the non-English language references cited on submitted Information Disclosure Statement is limited to the extent described for the cited non-English documents and any corresponding translations therein only so far as the particular portion respectively translated and without reference to a complete invention thereof. It is further noted that the translations are not attested as to their accuracy.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sone (U.S. Patent No. 5,919,047) in view of Tsai et al. (U.S. Patent No. 6,352,432; hereafter "Tsai").

Sone discloses a karaoke machine that includes first original music output means for outputting during automated karaoke play at least a main part of first original music containing the main part (Figure 7C, first music piece section) and a post-amble subsequent thereto (Figure 7C, end of the first music piece section); a second original music output means for outputting during automated karaoke play at least a main part of second original music containing a preamble (Figure 7C. beginning of the second music piece section) the main part subsequent thereto (Figure 7C, second music piece section); connection music output means for outputting during automated karaoke play predetermined connection music (Figure 7C, Bridge Section, 10:7-42); timing control means for controlling during automated karaoke play the second music output means and the connection music output means such that main part end timing of the original music coincides with start timing of the connection music, and the main part start timing of the second original music coincides with output with output end timing of the connection music (10:7-42), but does not disclose that the karaoke device is a type of game. However, Tsai

discloses a karaoke machine that is a game device that sets up a competition between two opposing karaoke singers (apparatus) in order to determine who the crowd thinks is the superior karaoke singer. One would be motivated to combine the references in order to provide a match between two singers and to determine who the better singer is. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the karaoke game play of Tsai into the karaoke machine of Sone in order to provide a match between two singers and to determine who the better singer is.

Referring to claims 2 and 3, Sone in view of Tsai disclose the ability to adjust the volume (Sone 10:7-42).

Referring to claims 4-6 and 33-35, Sone discloses that in order to ensure a smooth transition from a first piece of music to a second piece of music, the device uses cross-fading for the volume and the tempo (Figure 7C; 10:7-42).

Referring to claims 7-9, Sone in view of Tsai disclose a game machine that has the ability to storing audio data (Sone 3:39-51)

Referring to claim 10, Sone in view of Tsai disclose a game machine that has original music storage means, original music end timing storage means, connection music storage means (Sone 10:7-42, 11:61-63), original music reproduction means, main part end timing monitoring means, connection music output means and volume control means (Sone 10:7-42).

Referring to claims 11 and 12, Sone in view of Tsai disclose a game machine that has original music storage means, main part start timing storing means, connection music storage means, original music reproduction start timing storage means, connection music output means, original music reproduction start timing monitoring means, original music reproduction means,

main part start timing monitoring means and volume control means, the volume not adjusting as the music is reproduced.

Claims 13-15 correspond in scope to a method set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 16-18 correspond in scope to an information storage medium set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 19-20 correspond in scope to a distribution device set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Claim 21 corresponds in scope to a game machine set forth for use of the game machine listed in the claims above and is encompassed by use as set forth in the rejection above.

Referring to claim 22, Sone in view of Tsai disclose a game machine of which controller is operated by a player in accordance with game music, the machine including input means for setting a play conditions (Tsai discloses either one or multiple of players can compete in the game), storage means for storing the play conditions and game advancing means for advancing a game according to the play condition stored wherein the game advancing means includes the ability to output music relating to the game.

Referring to claim 23, Sone in view of Tsai disclose the game advancing means further comprises timing guidance image display means for displaying timing guidance image in conformity with the play condition stored in the play condition storage means, for guiding timing

at which the player is to operate the controller in accordance with the game music (Tsai discloses two players fighting based upon frequency, volume, rhythm and the total points 4:56-5:2).

Referring to claim 24, Sone in view of Tsai disclose a game machine of which controller is operated by a player in accordance with game music, the machine including input means for setting a play conditions, storage means for storing the play conditions and game advancing means for advancing a game according to the play condition stored wherein the game advancing means includes the ability to output music relating to the game, the ability to change and control the music in real time based upon player's preferences by adjusting the music editor, but does not disclose that the original music determination means determines the original music to output based on a random number. However, it is notoriously well known in the art to use random music in order to update the game so the sound does not create redundancy in the game. The random generation of sound could ensure that the game would create interest in the game for a longer period of time. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the random generation of the music to Araki's invention in order to create a game that is non-repetitive in nature and therefore, could keep player's attention for a longer time period.

Claims 25-29 correspond in scope to a game machine set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 30-32 correspond in scope to a computer readable storage medium set forth for use of the game machine listed in the claims above and are encompassed by use as set forth in the rejection above.

***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 7-12, 14-23, and 24-32 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed June 5, 2003 have been fully considered but they are not persuasive.

Applicant argues that Sone does not use the original music structure comprising a main piece with a preamble and/or post-amble and a predetermined connection music, with timing for the connection music that depends on timing of the preamble and/or post-amble as claimed. However, Sone discloses at Figure 7C a first music piece section having a post-amble (Figure 7C, the end of the first music piece section) and a second music piece section that has a preamble (Figure 7C, the beginning of the second music piece section) and the connection music (bridge section), wherein the timing/rhythm for the bridge section is mixed to make a smooth transition (10:7-42). Therefore, the claimed invention fails to preclude the invention of Sone in view of Tsai.

Further, it is noted that the Applicant's failed to reasonably traverse examiner's well known statements in their response, therefore, the object of the examiner's statements (e.g. well known in the art to use random music in order to update the game so the sound does not create redundancy in the game) is taken as admitted prior art. *In re Chevenard*, 139 F.2d 711, 60 USPQ 239 (CCPA 1943).

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc
June 17, 2003

MARK SAGER
PRIMARY EXAMINER